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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/752,026 | 12/29/2000 | Gary E. Sullivan | 257/127 | 8705 |

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GATEWAY, INC.
ATTN: PATENT ATTORNEY
610 GATEWAY DR.
MAIL DROP Y-04
N. SIOUX CITY, SD 57049

| EXAMINER | |
|---|---|
| LE, DEBBIE M | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 2168 | |

DATE MAILED: 02/21/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 09/752,026 | SULLIVAN ET AL. | |
| | Examiner | Art Unit | |
| | DEBBIE M. LE | 2168 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *09 December 2005*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-24* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-24* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

## DETAILED ACTION

Applicant's arguments filed on 12/9/05. Claims 21-24 are newly added. Claims 1-24 are pending for examinations.

### *Claim Rejections - 35 USC § 103*

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 1-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Peng (US Patent 6,738,766 B2) in view of Howe et al (US Patent 6,917,958 B1).

As per claim 1, Peng discloses a system for storing and retrieving data (col. 2, lines 32-48), comprising:

an identifier including three or more variables for identifying each data stored in said system, wherein one of said at least three or more variables is a location variables (Figs. 2b, 3a-b, col. 4, lines 64, col. 5, lines 1-7).

Peng does not explicitly teach a physical location. However, Howe teaches at a physical location variable (as a value is in a system registry "C:\test.ini) (col. 10, lines 54-60). Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to identify a variables is a physical location as disclosed by Howe because it would speed up a searching process of Peng's system if a user provides a physical location to identify, for example, where a file resides at.

As per claims 2, Peng teaches wherein one of said three or more variables is a device identification variable, a timestamp for prioritizing said data, wherein one of said variables may be filled by a wildcard, wherein said system includes a registry for storing said data, wherein said registry is provided in a database structure (Fig. 8, Fig. 3b, col. 5, lines 1-3, 48-65).

As per claims 7-10, Peng teaches wherein said three or more variables includes a device identification variable, an application identification variable and a user identification variable, a timestamp for prioritizing data, wherein one of said variables may be filled by a wildcard, wherein said system includes a registry and said registry includes a database structure for storing said data (Fig. 8, Fig. 3b, col. 5, lines 1-3, 48-65).

Claims 11 and 14 are rejected by the same rationale as state in independent claim 1 arguments.

As per claims 12-13, Peng teaches a means for providing a floating value to said at least three variables, a means for associating a time stamp to said data. (col. 5, lines 1-3).

Claims 16-18, 20-21 have similar limitations as claims 2-10; therefore, they are rejected under the same subject matter.

As per claim 19, Peng teaches deleting one or more data items that has been superseded by a subsequent data having same identifier but a higher time stamp value (Fig. 8, # 810).

As per claim 22, Howe teaches wherein at least one of said stored data further includes preference data (col. 2, lines 29-36, 64-67, col. 3, lines 1-4).

Claims 23-24 have the same limitations as claim 22, therefore, they are rejected under the same subject matter.

***Response to Arguments***

Applicant's arguments filed 12/9/05 have been fully considered but they are not persuasive.

First, Applicant argues that the combination of Peng and Howe references is necessarily the improper product of hindsight because Howe is concerned with distribution of system file and system registry changes is added to a client machine while Peng's invention is concerned with providing personalized application search

results for wireless devices based on user profiles. That is the combination would "speed up a searching process" of Peng does not follow from the actual teachings of Peng reference.

In response to applicant's argument that the examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

In this particular case, Howe's invention discloses "as users becomes more technically sophisticated through everyday use of various computing devices, users demand more options in their **access to data** and computing resources. For example, people who travel extensively or **work at various locations** may rely on **the ability to have access** to a common set of applications wherever they are located. Enormous costs and amounts of time may be spent on accommodating **user preferences** while pursing corporate directives for the use of standard configurations (col. 2, lines 29-38). Thus, "updates to the operating system including configuration changes, operating system settings, **device drivers,** installation of applications all use the registry to store and **retrieve information** from values within the registry. The registry contains information that is partitioned into two sections. General system information is found in

one section and **user specific information is found in the other section of the registry."** (col. 2, lines 64-67, col. 3, lines 1-4). That is, Peng's invention is concerned with providing personalized application search results for wireless devices **based on user profiles** and if the user profiles of Peng's system would be stored **in one of the two sections** as mentioned by **Howe's invention**, "**user specific information is found in the other section of the registry"**. Thus, it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of the cited references to identify a variables is a physical location as disclosed by Howe because it would enable Peng's system to **retrieve** personalized application based on **"user specific information"** which is stored "**in the other section of the registry".** Therefore, the combination of the cited references would provide a benefit in a manner of speed up a searching process of Peng's system by using the actual user specific information section location within the registry for accessing user preferences data file.

Accordingly, the combination of Peng and Howe references is proper.

Second, Applicants' arguments that "the claims are obviously not limited to these examples, as provided for in the instant application, examples of such physical locations include home, living room, kitchen, etc. (e.g., as show in the drawings).

In response, it is noted that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. As passages from the Applicants argued "the invention specification and drawings which lists examples of physical locations such as home, living room, kitchen, etc can be

found throughout the specification as filed", they were not claimed explicitly. It is the claims that define the claimed invention, and it is claims, not specifications that are anticipated or unpatentable. *Constant v.Advanced Miro-Devices Inc., 7 USPQ2d 1064.*

As a result, Howe's invention discloses the claimed element "physical location", as broadly claimed by the Applicant.

***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DEBBIE M. LE whose telephone number is (571) 272-4111. The examiner can normally be reached on 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, JEFFREY GAFFIN can be reached on (571) 272-4146. The fax phone

number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DEBBIE M LE
Examiner
Art Unit 2168

Debbie Le

Feb. 7, 2006.